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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,648	12/11/2003	Robert J. Garabedian	03-227 US	9116
23410	7590	08/04/2006	EXAMINER	
Vista IP Law Group LLP 2040 MAIN STREET, 9TH FLOOR IRVINE, CA 92614			TOY, ALEX B	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/734,648

Applicant(s)

GARABEDIAN ET AL.

Examiner

Alex B. Toy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-36 is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This Office Action is in response to applicant's amendment filed on March 24, 2006. Claims 1-14 stand rejected. Claims 15-36 are allowed.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherry (U.S. Pat. No. 6,221,071 B1) in view of Shafirstein (U.S. Pat. No. 6,780,177 B2).

Regarding claim 1, Sherry discloses a medical probe assembly for ablating tissue, comprising:

an elongated shaft 14 having a deployment member 30 configured to linearly expand (col. 6, ln. 17-30 and Figs. 6A-6B);

an electrode array 20 comprising a plurality of needle electrodes (col. 5, ln. 45-46 and Figs. 3 and 6B), the electrode array mechanically coupled to the deployment member 30 (Figs. 6A-B), wherein the electrode array is configured to be axially displaced in a distal direction and at least one of the needle electrodes is configured to assume an outwardly curved shape when the deployment member linearly expands (Figs. 6A-B).

The claim differs from Sherry in calling for the deployment member to be configured to expand in response to being exposed to a first temperature. Shafirstein, however, teaches a medical probe assembly for ablating tissue, wherein a deployment member 32 is configured to linearly expand when exposed to a first temperature (col. 5, ln. 59 – col. 6, ln. 7 and Fig. 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the deployment member of Sherry to be configured to linearly expand when exposed to a first temperature, in view of the teaching of Shafirstein as an obvious alternate method of expanding a spring to deploy ablation elements that is known in the art.

Regarding claim 9, Sherry discloses the medical probe assembly of claim 1, further comprising a deployment member 30, the deployment member configured to linearly expand (col. 6, ln. 17-30 and Figs. 6A-6B). The claim differs from Sherry in calling for the deployment member to be mechanically coupled between the electrode array and the shaft. Shafirstein, however, teaches a medical probe assembly for

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ablating tissue, wherein a deployment member 32 is mechanically coupled between an ablation element 30 and a shaft (col. 5, ln. 59 – col. 6, ln. 7 and Fig. 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the deployment member of Sherry to be coupled between the electrode array and the shaft, in view of the teaching of Shafirstein as an obvious alternate method of expanding a spring to deploy ablation elements that is known in the art.

Regarding claims 10 and 11, Sherry discloses the medical probe assembly of claim 1 in view of Shafirstein. Since the deployment member of Shafirstein expands in response to a heating element, it would be obvious and require only routine skill in the art to configure the deployment member to expand when exposed to a temperature greater than body temperature and equal to a tissue ablation temperature.

Regarding claims 12 and 13, Sherry discloses the medical probe assembly of claim 1 in view of Shafirstein. In addition, the deployment member of Shafirstein comprises a Nitinol spring (col. 6, ln. 4-5 and Fig. 6).

Regarding claim 14, Sherry discloses the medical probe assembly of claim 1 in view of Shafirstein, further comprising a cannula 10 having a lumen, wherein the shaft is reciprocatably disposed within the cannula lumen (col. 4, ln. 10-15 and Figs. 1 and 3)

Claims 2 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherry (U.S. Pat. No. 6,221,071 B1) in view of Shafirstein (U.S. Pat. No. 6,780,177 B2) and further in view of Zepeda (WO 99/25260).

Regarding claims 2, 5, and 6 Zepeda teaches expanding an array of needle electrodes 16 using temperature-sensitive shape alloy material that assumes an outwardly curved shape when exposed to a first temperature that is greater than body temperature and equal to a tissue ablation temperature (pg. 7, ln. 20 – pg. 8, ln. 4 and Fig. 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the shape memory alloy electrode array of Sherry temperature-sensitive and assume an outwardly curved shape when exposed to a first temperature as claimed in view of the teaching of Zepeda as an obvious alternate way of expanding shape memory alloy electrodes that is known in the art.

Regarding claims 7 and 8, Zepeda also discloses that the temperature-sensitive needles are straight in response to being exposed to a second temperature that is less than the first temperature and is body temperature to allow the needles to be retracted inside a sheath while being positioned inside the body (pg. 7, ln. 20 – pg. 8, ln. 4). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the shape memory alloy electrode array of Sherry temperature-sensitive and assume a substantially straight shape when exposed to a second temperature as claimed to allow the needles to be retracted inside the sheath while being positioned inside the body.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherry (U.S. Pat. No. 6,221,071 B1) / Shafirstein (U.S. Pat. No. 6,780,177 B2) / Zepeda (WO 99/25260) and further in view of Sharkey (U.S. PGPub 2001/0031963).

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Regarding claim 3, Sherry discloses the medical probe assembly, wherein the at least one needle electrode comprises a nickel-titanium alloy (col. 4, ln. 61-65) but not specifically Nitinol. Sharkey, however, teaches a medical probe assembly for ablating tissue wherein at least one needle electrode comprises Nitinol (pg. 8, ¶ 96). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the needle electrode of Sherry from Nitinol in view of the teaching of Sharkey as an obvious specific type of nickel-titanium alloy that is well-known in the art.

Regarding claim 4, the claim differs from Sherry in calling for the needle electrode to be bi-metallic. Sharkey, however, teaches a temperature sensitive bi-metallic needle electrode as an alternate means of making an electrode curve outwardly (pg. 8, ¶ 95). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the electrodes of Sherry bi-metallic in view of the teaching of Sharkey as an obvious alternate means of making electrodes curve outwardly that is known in the art.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-14 have been fully considered but they are not persuasive.

Regarding independent claim 1, Sherry discloses the disputed element of a linearly expanding deployment member that axially displaces the electrode array in a distal direction (Figs. 6A-6B). The claim only differs from Sherry in calling for the

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deployment member to be configured to expand in response to being exposed to a first temperature. Shafirstein discloses such a deployment member. The examiner acknowledges that the razorblades 30 are not electrodes. However, the razorblades 30 still constitute ablation elements since they use heat to destroy tumors (col. 2, ln. 6-7 and col. 5, ln. 59-62). Since both the spring of Sherry and the spring of Shafirstein are deployment members that move axially to deploy ablation elements, the two devices are analogous and deal with solving the same problem. Therefore, rejection under 103(a) is proper.

All other arguments with respect to claims 1-14 have been considered but are moot in view of the new grounds of rejection.

Applicant's arguments with respect to claims 15-36 have been fully considered and are persuasive. The rejections of claims 15-36 are withdrawn.

### ***Allowable Subject Matter***

Claims 15-36 are allowed.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex B. Toy whose telephone number is (571) 272-1953. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AT *AT*  
7/24/06

*Michael Peffley*  
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PRIMARY EXAMINER